

REMARKS

**Introduction**

In response to the Office Action dated February 21, 2009, Applicant has amended claims 21 and 25. Support for amended claim 21 is found in, for example, pg. 6, lines 8-18. Claim 25 has been amended to address the antecedent support issue identified by the Examiner. Care has been taken to avoid the introduction of new matter. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all pending claims are in condition for allowance.

**Claim Rejection Under 35 U.S.C. § 112**

Claims 21-33 are rejected under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Office Action asserts that it is unclear whether "the or each video-game controller" and "one or more video-game controllers" recited in claims 21 and 25 are the same.

Applicant respectfully submits that the rejection is moot in view of the foregoing amendment of claims 21 and 25 that provide explicit antecedent support for "the at least one video-game controller."

The Office Action asserts that the phrase "and/or" is indefinite since it is unclear as to what is being claimed. The

Office Action states that the Examiner considers the video-game controllers and consoles to not be positively claimed and are functional language to help define other structures.

Applicant traverses.

The mere use of an alternative expression in a claim is not fatal. See, *Ex parte Head*, 214 USPQ 551, 553 (B.P.A.I. 1981).

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim. *In re Cortwright*, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. American Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir.

1988). Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc., supra.*

In applying the above legal tenets to the exigencies of this case, Applicant submits that one having ordinary skill in the art would not have been befuddled by the claimed subject matter. Moreover, the Examiner's ultimate legal conclusion of indefiniteness ignores the basic legal tenet requiring claims to be interpreted through the eyes of one having ordinary skill in the art in light of and consistent with the written description of the specification. The Examiner failed to even attempt to offer up a reasoned analysis **why** one having ordinary skill in the art would have been confused by the claim language, particularly when reasonably interpreted in light of and consistent with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc., supra.* The rejection is not legally viable for at least this reason. Nonetheless, in order to advance prosecution on the merits, Applicant has amended some of the claims for clarity.

According to MPEP § 2173.05(h), alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 § U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of;" "at least one piece;" and "iron, steel, or any other

magnetic material.” The mere fact that one group may be broader than another is insufficient to reject the claim as indefinite. See, e.g., MPEP 2173.05(h) stating that a Markush group reciting both a “halogen” and “chloro” was acceptable even though halogen is generic to chloro.

With respect to the video-game controllers and consoles, there is a cooperative relationship between the video-game controllers and video-game consoles and the structural features of the gaming furniture. The video-game controllers and video-game consoles of the Applicant’s gaming furniture are not merely ornamental; both are there because they define the size and structure of the claimed interior space of the container. Thus, this feature of the Applicant’s invention, which is expressed both structurally and functionally in the claim, cannot be ignored.

Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed subject matter, particularly when reasonably interpreted in light of the supporting specification. Therefore, it is respectfully submitted that the imposed rejection under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicant solicits withdrawal thereof.

**Claim Rejection Under 35 U.S.C. § 102**

Claims 21-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,804,122 to Baum.

The Office Action asserts that Baum teaches furniture having a container with a platform 70 connected to the base of an articulating arm mechanism (56, 40, 48). The Examiner contends that, in Fig. 3, a side is considered to be pivotal since a portion of the side pivots with the top. The Office Action asserts that a leg member 30 supports the platform. The Office Action states that the Examiner considers the video-game controllers and consoles to not be positively claimed and are functional language to help define other structures.

An aspect of amended claim 21 is gaming furniture having a support platform where the support platform arrangement is fully receivable within the interior space and foldable to project out of the container. Another aspect of amended claim 21 is a foldable leg member that extends between one of the sides of the container and the support platform arrangement to support the unfolded support platform arrangement.

Baum shows, in Fig. 3, sides (11, 16) and a top 20 of combination footstool and table where the support platform arrangement corresponding to a flat, tray-like table-top member 70 is pivotally mounted and supported by a jointed arm 40 and a panel-like member 30 extending from interior of the structure. However, the *unfolded* support platform arrangement 70 of Baum is

not supported by a foldable leg member that extends between one of the sides and the support platform arrangement, as required by amended claim 21.

With respect to the alleged functional limitations of the video-game controllers and consoles, both limitations define the size and structure of the claimed interior space of the container. However, a functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004).

In this case, the functionality set forth in claim 21 clearly delineates the structure of the present invention in relation to the function, that can be, for example, furniture

with an interior space to hold video-game controllers and consoles.

There is clearly no indication of this type of structure and function in Baum. Baum thus fails to disclose each and every limitation of claim 21.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Baum does not anticipate amended claim 21 nor any claim dependent thereon.

Entry of the above amendments is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any

additional fees required under 37 C.F.R. § 1.16 or under 37  
C.F.R. § 1.17.

Respectfully submitted,

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